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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS R. GOECKE

Appeal 2008-004501
Application 10/674,108
Technology Center 1700

Decided:¹ July 16, 2009

Before CATHERINE Q. TIMM, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests reconsideration of our Decision of February 19, 2009 (“Decision”) wherein we sustained the Examiner's rejections of the appealed claims under 35 U.S.C. § 103(a). (Request for Rehearing (“Req.”)),

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

filed Apr. 23, 2009.) Appellant contends that the Board erred in its Decision for the following reasons (hereinafter “Reasons”):

1. neither the Examiner nor the Board identified a disclosure or suggestion in the applied prior art of the polymer plus adhesive thickness of .065-.069 inch recited in claim 11 (Req. 2-3);
2. the Examiner and the Board incorrectly found that the slight overlap between Oace’s disclosed thickness range of .004 to .020 inches and the range of .020 to .065 inches recited in claims 1 and 12 was sufficient to establish an anticipation of the claimed range (Req. 3-4);
3. the Examiner and the Board overlooked the fact that modification of Oace’s tape to increase its hardness to the claimed Shore A Hardness range would render the tape inelastic and, therefore, unsatisfactory for its intended purpose (Req. 5-6 (discussing claims 1-7 and 9-11));
4. the Examiner and the Board overlooked the fact that modification of Oace’s adhesive layer based on Guenther’s disclosure would render Oace’s tape unsatisfactory for its intended purpose since Guenther relates to a permanent adhesive (Req. 6-7 (discussing claim 12); and
5. the Board relied on a different embodiment in Guenther than the Examiner, and modification of Oace’s adhesive in view of this embodiment would have resulted in a combination which fails to include all of the limitations recited in claim 12 (Req. 6-7).

We have reviewed our Decision in light of the arguments presented by Appellant in the Request. However, we are not persuaded that our Decision was in error.

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir.

2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.” (*quoting In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998))). Therefore, we look to Appellant’s Brief to show error in the proffered prima facie case. *See* 37 C.F.R. § 41.37(c)(1)(vii) (“Any argument or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown.”). With respect to a Request for Rehearing of the Board’s Decision, 37 C.F.R. § 41.52(a)(1) provides that an Appellant must “state with particularity the points believed to have been misapprehended or overlooked by the Board in its Decision.” This section further states that “[a]rguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing.” *Id.*

Appellant’s Reasons 1-4 contain arguments which were not previously raised in Appellant’s Appeal Brief. In other words, because these arguments were not previously before the Board, it is improper for Appellant to identify these Reasons as “points believed to have been misapprehended or overlooked by the Board in its Decision” (37 C.F.R. § 41.52(a)(1)). However, while these arguments will not be addressed on the merits, we do point out at least the following inaccuracies in Appellant’s Reasons:

Turning first to Reason 1, Appellant is directed to Findings of Fact (“FF”) 6, 7, and 10 of the Decision which clearly identify Oace as teaching the recited thickness limitation. In the Appeal Brief, Appellant did not (*see* Decision 10), nor does he currently (*see* Req. 4), dispute the Examiner’s

finding that the thickness of Oace's tape overlaps Appellant's claimed range. With respect to Reason 2, we note that the claims were rejected under 35 U.S.C. § 103, not under 35 U.S.C. § 102. Our reviewing court has consistently held that a prima facie case of obviousness exists where the prior art and claimed ranges overlap, as well as in those cases where the claimed range and the prior art range, though not overlapping, are sufficiently close that one skilled in the art would have expected them to have the same properties. *See, e.g., In re Peterson*, 315 F.3d 1325, 1329 (Fed. Cir. 2003); *In re Geisler*, 116 F.3d 1465, 1469 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 783 (Fed. Cir. 1985). Turning to Reasons 3 and 4, Appellant is directed to FF 12 which indicates that the Board considered a related issue raised in the Appeal Brief, but determined that it was not persuasive of reversible error (*see* FF 11 and Decision 10 (explaining that "Appellant did not address the Examiner's rationale for rejecting the claims")). However, Appellant has not identified, nor do we find, where the arguments contained in Reasons 3 and 4 were previously presented in the Appeal Brief.

Turning now to Reason 5, Appellant is directed to FF 4 which lists the factual findings relied on by the Examiner in rejecting claim 12 (*see* Ans. 4). Appellant is further directed to the Analysis portion of the Decision (pp. 9-10) which clearly indicates that the Board's affirmance is based on Appellant's failure to identify error in the facts and reasons relied on by the Examiner in rejecting the claims.

In conclusion, based on the foregoing, we have granted Appellant's request to the extent that we have reconsidered our Decision, but we deny Appellant's request to make any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

DENIED

PL Initial:
sld

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